

13071BAUS02U

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Schofield et al.
Serial No.: 09/931,643
Filed:
For: OPTICAL SWITCH ROUTER
Art Unit:
Examiner:

Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

**PETITION UNDER 37 C.F.R. § 1.146(a) TO PERMIT ENTRY OF DECLARATION WHEN INVENTOR
REFUSES TO SIGN OR CANNOT BE REACHED**

Please accept this application on behalf of Bruce A. Schofield, Michael Craren and James Luciani. Bruce Schofield and Michael Craren have signed the attached oath and declaration. Diligent attempts (detailed in the attached attorney affidavit) to obtain Mr. Luciani's signature at his last known address of:

James V. Luciani
9 Shady Lane
Acton MA 01720

However, these attempts were not met with success.

In view of the diligent attempts to obtain Mr. Luciani's signature, it is requested that the Commissioner allow this application to proceed to review in the absence of Mr. Luciani's signature. The appropriate fee under 1.17(h) is enclosed.

06/03/2002 SMINASS1 00000002 501940 09931643

04 FC:122 130.00 CH

Respectfully Submitted,

May 16, 2002

By: 

Lindsay G. McGuinness
Reg. No. 38,549
Attorney for Applicant
Nortel Networks
600 Technology Park Drive
Billerica MA 01821

Attachment: Affidavit by Attorney for Applicant, Lindsay G. McGuinness
Exhibits A-D

AFFIDAVIT OF DILIGENCE PURSUANT 37 C.F.R. §1.46(a)

Stated below are the facts attempting to illustrate diligence on the part of Applicants attorney to contact the James Luciani, to obtain his signature on the application documents.

After receiving the notice of missing parts for this application, on December 20, 2001, I mailed a copy of the application, and the assignment, declaration and power of attorney paperwork to the homes of Mr. Craren and Mr. Luciani, and hand- delivered a copy to Mr. Schofield. In January 2002, I received the signed paperwork from Mr. Craren and Mr. Schofield. A copy of that letter is attached hereto as exhibit A.

Mr. Luciani left the employ of Nortel Networks on or about May of 2000. He has been an inventor on other Nortel applications, and, I understood from my discussion with other attorneys in the department, had historically increasingly expressed his frustration with having to sign and return documents to the law department.

In January 2002, having not received the paperwork from Mr. Luciani, I called the telephone number associated with his last known address, and left a message asking him to contact me if he had any questions regarding the patent documents. I received no reply. On or about March 2002, I again called Mr. Luciani's home, asking him to call me regarding the execution of documents for the patent application. I again received no reply.

In April 17, 2002, I again sent, by certified mail delivery this time, a copy of the patent and the necessary signature documents to Mr. Luciani's last known address of 9 Shady Lane, Acton, Massachusetts, 01720. Mr. Luciani was notified of the certified package on April 19, April 26th and May 4th, but he did not claim the package. A copy of the front of the envelope is attached hereto as exhibit B, and copy of the letter of April 17th is attached hereto as exhibit C.

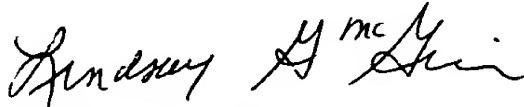
Given my understanding of Mr. Luciani's feelings about Nortel, and his actions in this matter, it is my belief that Mr. Luciani, knowing the certified package was a package from Nortel Networks, chose not to retrieve it from the post office. I believe that I have shown diligence, through my actions, in attempting to obtain Mr. Luciani's signature.

Attached hereto as exhibit d is Mr. Luciani's employee agreement with Bay Networks, a subsidiary of Nortel Networks, and we hereby submit that Nortel Networks is the owner of 100% interest in this application.

Certification under 37 C.F.R. §3.73(b)

I also certify that I am empowered to act on behalf of the organization. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

May 16, 2002


Lindsay G. McGuinness
Attorney for Applicant
Nortel Networks

09/740,052

Billerica MA 01821

Exhibit A

NORTEL
NETWORKS

COPY OF PAPERS
ORIGINALLY FILED

Nortel Networks
600 Technology Park Drive
Billerica MA 01821 - 5501
Tel 978 288 3800

www.nortelnetworks.com

Bruce Schofield
15 Farewell Road
Tyngsboro, MA 01879

James V. Luciani
9 Shady Lane
Acton, MA 01720

Michael J. Craren
107 Juniper Road
Holliston, MA 01746

December 20, 2001

RE: Patent Application Serial No. 09/931,643
For: Optical Switch Router
Our Reference: 13071BAUS02U

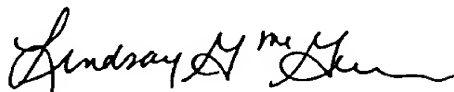
Bruce, James and Michael,

Enclosed you will find a copy of an Assignment and a Declaration that needs to be signed for the above identified patent application. I would appreciate it if you could sign the documents, and return to me in the self-addressed, stamped envelope at your earliest convenience.

Please do not hesitate to contact me if you have any questions or concerns.

Thank you for your assistance, and hope you have a great holiday.

Sincerely,



Lindsay G. McGuinness
Corporate Counsel
Nortel Networks, Inc.
600 Technology Park Drive
Billerica MA 01821

(978) 288-6304

UNITED STATES POSTAL SERVICE



First-Class Mail
Postage & Fees Paid
USPS
Permit No. G-10

Exhibit B

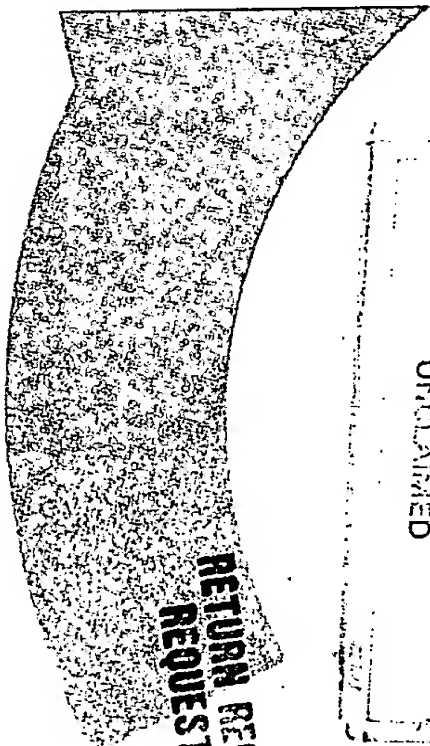
**ORTEL
NETWORKS**

Dept/Dep _____

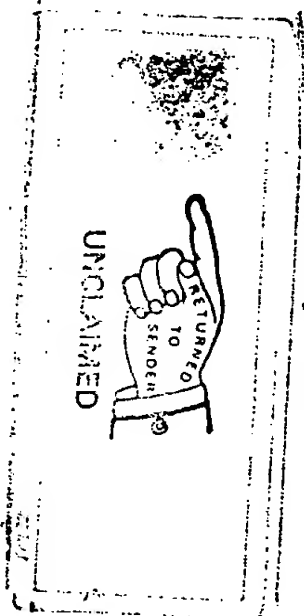
COPY OF PAPERS
ORIGINALLY FILED

• Sender: Please print your name, address, and ZIP+4 in this box •

McGuinness
c/o Nortel Networks
600 Technology Park
Billerica MA 01742



**RETURN RECEIPT
REQUESTED**



James V. Luciani
9 Shady Lane

**RETURN TO
SENDER**

☒ UNKNOWN, LEFT NO ADDRESS
☒ NOT DELIVERABLE AS ADDRESSED
☒ UNABLE TO FORWARD

☐ ATTEMPTED - NOT KNOWN
☐ UNLABLED TO RETURN
☐ NO SUCH STREET NUMBER
☐ DO NOT REDELIVER IN THIS ENVELOPE
☐ MISSING/EMPTY ADDRESS
☐ EXCESS MAIL OR POSTAGE
☐ EXCESS WEIGHT OR DIMENSIONS
☐ NO POSTAGE PAID

**RETURN RECEIPT
REQUESTED**

7001 2510 0003 1918 6581



POSTAL SERVICE

9264

4/19
4-26-02
5-4-02

Nortel Networks
600 Technology Park Drive
Billerica MA 01821 - 5501
Tel 978 288 3800

www.nortelnetworks.com

James V. Luciani
9 Shady Lane
Acton, MA 01720
978-266-2918
CERTIFIED MAIL

April 17, 2002

RE: Patent Application Serial No. 09/931,643
For: Optical Switch Router
Our Reference: 13071BAUS02U

Dear James:

Enclosed you will find a second copy of the Assignment and a Declaration that needs to be signed for the above identified patent application.

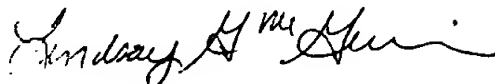
I have heard no response from you with regard to the documentation that was sent to you on December 20, 2001, nor have you responded to my phone calls. I am unclear as to whether that indicates that you do not wish to sign the documents, and if not, what the reason is. Please do not hesitate to contact me at 978-288-6304 if you have an issue with signing the documents.

I would appreciate it if you could sign the documents, and return to me in the self-addressed, stamped envelope. Please note that there is **NO NOTARIZATION** requirement for the assignment, merely a witness signature.

If I do not hear from you by May 15th, 2002, I will assume, by your lack of response, that you do not wish to sign the documents.

Please do not hesitate to contact me if you have any questions or concerns. Thank you for your assistance in this matter.

Sincerely,



Lindsay G. McGuinness
Corporate Counsel
Nortel Networks, Inc.
600 Technology Park Drive
Billerica MA 01821
(978) 288-6304

Exhibit D-1

**Bay Networks**

The Merged Company of SynOptics and Wellfleet

COPY OF PAPERS
ORIGINALLY FILED**EMPLOYEE INVENTION ASSIGNMENT and
PROPRIETARY INFORMATION AGREEMENT**

I, the undersigned, acknowledge, represent, and agree, in consideration of the commencement or continuation of my employment by Bay Networks, Inc. or an affiliate of Bay Networks (collectively "Bay Networks"), and the compensation promised me, that:

1. I understand that my employment by Bay Networks creates a relationship of confidence and trust with respect to any information of a confidential or secret nature that may be developed by me in my capacity as an employee of Bay Networks or may be disclosed to me by Bay Networks that relates to the business of Bay Networks or to the business of any parent, subsidiary, affiliate, customer or supplier of Bay Networks, or of any other third party who entrusted the same to Bay Networks ("Proprietary Information"). Such Proprietary Information includes, but is not limited to, technical and business information relating to Bay Networks' inventions or products, research and development, marketing plans, product plans, business strategies, financial information, forecasts, production, manufacturing and engineering processes, personnel lists and information relating to skillset and compensation, and customer and prospective customer lists whether or not it is in written or permanent form. Such Proprietary Information does not include any information which is or becomes part of the public domain not in violation of any agreement with Bay Networks.
2. At all times, both during the period I am employed by Bay Networks and after termination of my employment, I will keep all Proprietary Information in confidence and trust, and I will not use or disclose any Proprietary Information without the written consent of Bay Networks, except as authorized by Bay Networks. Upon termination of my employment by Bay Networks or upon request by Bay Networks, I will promptly deliver to Bay Networks all documents and materials of any nature pertaining to my work with Bay Networks, and I will not take with me any documents or material or copies thereof containing any Proprietary Information. I agree to be bound by all obligations and restrictions imposed by third parties on Bay Networks regarding inventions made during the course of work under agreements with those third parties or regarding the confidential nature of that work.
3. I will promptly disclose in writing to Bay Networks all inventions, improvements, original works of authorship, formulas, processes, computer programs, databases, technical developments and trade secrets ("Inventions"), whether or not patentable, copyrightable, or subject to protection as trade secrets, that are made or conceived or first reduced to practice or created by me, either alone or jointly with others, during the period of my employment by Bay Networks, whether or not in the course of my work for Bay Networks.
4. I hereby assign and agree to assign to Bay Networks, my entire right, title and interest in and to all Inventions, patents (and all related applications) that are developed by me, alone, or with others using equipment, supplies, facilities, or trade secrets of Bay Networks; that result from work performed by me for Bay Networks; or that relate to the business or the actual or anticipated research or development of Bay Networks, and agree that all and any such Inventions will be the sole and exclusive property of Bay Networks. Any previous work done by me for Bay Networks relating in any way to the conception, design, development or support of products for the company is the property of Bay Networks. This agreement to assign shall specifically not apply to any invention developed by me which qualifies under the provision of California Labor Code Section 2870.
5. I will assist Bay Networks and its designees, both during and after my employment, to obtain, maintain and enforce patents, copyrights and other legal protections for Inventions in any and all countries as Bay Networks deems appropriate at the company's expense. I will keep and maintain adequate and current written records of all Inventions, which shall be and remain the property of Bay Networks. I hereby waive all claims to moral rights in any Inventions.

Exhibit D-2

6. This agreement does not apply to the specific inventions (if any) listed on Page 2 of this Agreement, but I will give Bay Networks such further non-confidential information as may be necessary to assist in the evaluation of the extent and significance of such inventions.
7. I agree that upon termination of my employment and for a period of one year thereafter (without regard to the reason for my employment ending), I will not recruit, or attempt to recruit, or induce or solicit Bay Networks employees to terminate their employment with Bay Networks, nor will I solicit, or attempt to divert or take away, the business or patronage of any of the customers or accounts, or prospective customers or accounts of Bay Networks which were contacted, solicited or served by Bay Networks during the course of my employment.
8. I represent that my performance of all the terms of this Agreement and my duties as an employee of Bay Networks will not breach any invention assignment, proprietary information, non-competition, or other agreement with any former employer or other party. I represent that I will not bring with me or use in the performance of my duties for Bay Networks any proprietary information or documents or materials of a former employer, or any other person or entity that has retained me, that I am now or shall become aware of which belongs to any of my former employers' or to anyone other than the company and which are not generally available to the public.
9. During my employment by Bay Networks, I will not engage in any employment, consulting or other activity in any business competitive with Bay Networks' business as presently conducted or as conducted at any future time during my employment.
10. I hereby authorize Bay Networks, without limitation to notify others, including customers of Bay Networks, other persons or entities that retain me and my future employers, of the terms of this Agreement and my responsibilities hereunder.
11. Unless there is a written employment agreement for a specified term in effect, I understand that my employment maybe terminated at any time, with or without cause, by me or Bay Networks. This Agreement does not obligate Bay Networks to employ me for any particular length of time. This Agreement shall survive termination of the Employee's employment.
12. I understand that in the event of a breach of this Agreement by me, Bay Networks may suffer irreparable harm and shall be entitled to injunctive relief to enforce this Agreement.
13. This Agreement supersedes all other agreements relating to the subject matter herein. If a court finds any provision of this Agreement invalid or unenforceable as applied to any circumstance, the other provisions of this Agreement will remain in full force and effect. This Agreement shall be effective as of the first day I am affiliated or was employed by Bay Networks, namely 3/25, 1996.

EMPLOYEE:

BAY NETWORKS, INC.

Signature:

By: _____

Printed Name:

JAMES V. LUCIANI

Printed Name: _____

Title: _____

EMPLOYEE'S PRIOR INVENTIONS (if any)

This is a true and complete list.

Initial: _____

Date: _____

Employment Invention Assignment and Proprietary Information Agreement

Page 2 of 2

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